

MAR 26 2003

Appl. No. : 09/997,310
Filed : November 28, 2001

T.C. 2800

REMARKS

This communication is responsive to the December 26, 2002 Office Action. Claims 1-35 are pending in this application. The Examiner objected to Claims 6, 16, and 27-35. The Examiner rejected Claim 18 under 35 U.S.C. § 112 for lack of enablement. The Examiner rejected Claims 1, 2, 7, 9, 11, 12, 17, 18, 20 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,341,727 to Dickson ("Dickson"). The Examiner rejected Claims 3-5, 13-15, and 22-26 under 35 U.S.C. § 103(a) as being unpatentable over Dickson in view of U.S. Patent 6,326,754 to Mullet et al. ("Mullet"). The Examiner rejected Claims 8 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Dickson in view of U.S. Patent 6,400,112 to Fitzgibbon et al. ("Fitzgibbon"). The Examiner rejected Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Dickson in view of U.S. Patent 5,850,828 to Valentino ("Valentino").

Applicants would like to thank Examiner McCloud for the courtesies extended to Applicants' counsel, Perry D. Oldham, in a March 25, 2003 telephonic interview. Agreement was reached that Applicants would amend Claim 4 to overcome the indefiniteness rejection of Claims 4-6. Agreement was also reached that an amended specification would overcome the objection to informalities with respect to Claims 27-35. The Dickson, Mullet, Fitzgibbon and Valentino references were also discussed.

Applicants hereby amend Claims 1, 4, 12 and 18. Claims 1-35 are pending and presented for further consideration. Reconsideration of the application, as amended, is therefore respectfully requested.

Copy of Reference from IDS

Applicants are submitting herewith a duplicate of the Browne reference submitted with the February 14, 2002 Information Disclosure Statement.

Objection to Informalities

The Examiner objected to Claims 27-35 because the specification described an adjustable crossbar support arm for supporting a motor while the claims referred to a support beam. Applicants note that the specification describes at paragraph [0012], for example, an adjustable motor support beam. Further, in establishing a disclosure, an applicant may rely not only on the description and the drawings as filed but also on the original claims. See M.P.E.P. § 608.01(l).

Appl. No. : 09/997,310
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Original Claims 27-35 provide their own support for the use of "support beam." In an effort to further prosecution in this case, Applicants have amended the specification to use uniform terminology. These amendments are made with the understanding that the term "support beam" encompasses the term "support arm." No new matter has been added. Applicants respectfully submit that Claims 27-35 are in condition for allowance, and Applicants request withdrawal of the objection.

Rejection under 35 U.S.C. § 112

The Examiner rejected Claim 18 under 35 U.S.C. § 112, ¶ 1, as not being enabled by the specification. Applicants have amended Claim 18 to clarify that the motor is detachable from the cooking apparatus, regardless of where the motor was originally attached. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, ¶ 1.

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The Examiner rejected Claims 4-6 under 35 U.S.C. § 112, ¶ 2, as being indefinite. Applicants have amended Claim 4 to depend from Claim 3. Applicants respectfully submit that Claims 4-6 are in condition for allowance, and request withdrawal of the rejection under 35 U.S.C. § 112, ¶ 2.

Rejection under 35 U.S.C. § 102

The Examiner rejected Claims 1, 2, 7, 9, 11, 12, 17, 18, 20 and 21 under 35 U.S.C. § 102(b) as being anticipated by Dickson. Dickson relates to a gas-fired double-sided griddle that improves surface temperature uniformity while providing very fast response. A circulating hot oil system transfers heat to the cooking surfaces from a gas-fired oil heater. *See, e.g.*, Dickson at col. 2, lines 23-31.

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Dickson teaches positioning an upper cooking surface parallel to a lower cooking surface. *See, e.g.*, Dickson at col. 13, lines 16-18; col. 8, lines 9-11 ("Upper to lower platen parallelism is **crucial** for double-sided cooking uniformity.") (emphasis added). Thus, Dickson teaches away from a motor operating to adjust an angle of the opening between the cover and the grilling surface as recited in amended independent claim 1. *See* M.P.E.P. § 2141.02 (prior art must be considered in its entirety, including disclosures that teach away from the claims).

Dickson teaches positioning an upper cooking surface in contact with a food product. *See, e.g.*, Dickson at col. 2, lines 49-59; col. 6, lines 3-13; col. 6, lines 33-41; col. 8, lines 3-11;

Appl. No. : 09/997,310
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col. 9, lines 5-9; col. 11, lines 53-59; and col. 12, lines 62-68. Thus, Dickson teaches away from a cover that provides a hollow chamber having an adjustable opening over the grilling surface as recited in amended independent 12.

Further, Dickson fails to disclose a cover movement means for opening and closing the cover over the grilling surface as recited in independent claim 21. For example, nowhere does Dickson disclose a cover that may be closed over the grilling surface.

Claims 2, 7, 9, 11, which depend from independent claim 1, and claims 17, 18 and 20, which depend from independent claim 12, are believed to be patentable for the same reasons articulated above for the respective independent claims, and because of the additional features recited in the dependent claims. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b).

Rejection under 35 U.S.C. § 103

In order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. Dependent claims 3-5, 8 and 10, which depend from independent claim 1, dependent claims 13-15 and 19, which depend from independent claim 12, and dependent claim 22, which depends from independent claim 21, are believed to be patentable for the same reasons articulated above for the respective independent claims, and because of the additional features recited in the dependent claims.

Applicants further respectfully submit that the Examiner has failed to identify a sufficient suggestion to combine the cited references, and has therefore failed to establish a prima facie case of obviousness. When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See, e.g., *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The teaching or suggestion must be found in the prior art, not in the applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence' of motivation to combine. *Id.*

Appl. No. : 09/997,310
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The Examiner rejected dependent Claims 3-5, 13-15, and 22-26 under 35 U.S.C. § 103(a) as being unpatentable over Dickson in view of Mullet. There must be some suggestion or motivation to modify or combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01. There is no suggestion or motivation in the references to modify the double-sided griddle taught by Dickson to include the garage door opening apparatus taught by Mullet.

Dickson discloses the use of a computer to control the operation of a motor to adjust the spacing between upper and lower platens for different types of food. See Dickson at col. 12, line 68 - col. 13, line 2. There is, however, no motivation to replace the computer controlled motor of Dickson with the remote controlled motor of Mullet. Fine control of the motor is needed to avoid crushing soft food, and controlling the motor remotely is not conducive to the fine control needed. See Dickson at col. 13, lines 19-21.

The Examiner rejected dependent Claims 8 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Dickson in view of Fitzgibbon. As with Mullet, there is no suggestion or motivation in the references to modify the double-sided griddle taught by Dickson to include the garage door opening apparatus taught by Fitzgibbon.

The Examiner rejected dependent Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Dickson in view of Valentino. Dickson teaches the use of an oil temperature controller which turns a gas burner on or off to maintain the oil temperature. Thus, the oil-heated grill of Dickson is not combinable with the charcoal briquette fueled grilling surface taught by Valentino, as charcoal briquettes are not conducive to maintaining a constant oil temperature. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested.

In view of the foregoing amendments and remarks, Applicants submit that the claims are patentably distinct from the cited art, and request that the application be allowed.

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Appl. No. : 09/997,310
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MAR 26 2003

T.C. 2800

Arguments made with respect to specified claims apply only to those claims in this application and not other currently pending or later added claims in this or other applications. The amendment of a claim is not to be construed as acquiescence or admission that the cited art discloses the claim as previously read, and Applicants reserve the right to pursue such claims in a continuation or divisional application. Applicants traverse the original objections but have amended the claims in an effort to advance prosecution. Patentability is based on the claim as a whole, notwithstanding only a portion thereof is argued in support of novelty or non-obviousness. Any claim amendments that are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without entry of such amendments.

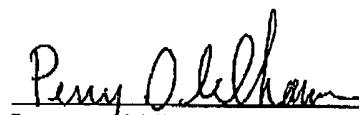
If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned attorney of record at his direct dial number of (949) 721-2961.

Respectfully submitted,

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Dated: 3/26/2003

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MAR 26 2003

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